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From: Alfred A. Stadnicki

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PETITIONS OFFICE

3350-04

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Docket No.: 3350-04
Client No.: RPP-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Technology Center 2100

In re Application of : Group Art Unit: 2163
GARRISON et al. :
Serial No. 09/010,193 : Examiner: Romain Jeanty
: **EXPEDITED PROCESSING**
Filed: January 21, 1998 : **REQUESTED**
For: DUAL SOURCE REMITTANCE PROCESSING

PETITION BRANCH

Honorable Assistant Commissioner
for Patents
Washington, DC 20231

I hereby certify that this paper or fee is
being sent via facsimile addressed to
Assistant Commissioner for Patents,
Washington, D.C. 20231

on October 18, 2001
Romain Jeanty
Signature

Sir:

Transmitted herewith is a Petition to the Commissioner Under 37 CFR §1.181 (a) (3) in the above-identified application.

- ☐ No additional fee is required.
☐ Also attached:

fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims			0	x \$18 =	\$0
Independent Claims			0	x \$80 =	\$0
Petition Fee Under 37 CFR §1.17(h)					\$130.00
TOTAL FEE DUE					\$130.00

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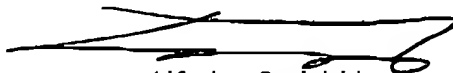
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☐ A check in the amount of \$_____ is attached

☒ Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 12-0429, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

LALOS & KEEGAN



Alfred A. Stadnicki
Registration No. 30,226

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Date: October 18, 2001

Docket No. 3350-04

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Group Art Unit: 2163
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: **EXPEDITED PROCESSING**
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FAX RECEIVED**OCT 18 2001****PETITIONS OFFICE****RECEIVED****OCT 24 2001****Technology Center 2100****PETITION TO THE COMMISSIONER**
UNDER 37 C.F.R. 1.181(a) (3)**PETITION BRANCH**

Honorable Assistant
Commissioner
for Patents
Washington, DC 20231

I hereby certify that this paper or fee is
being sent via facsimile addressed to the
Assistant Commissioner for Patents,
Washington, D.C. 20231

on October 18, 2001...

[Signature]
Signature

Sir:

In view of the nature of this Petition and the time limits running against Applicants (a second Appeal Brief must be filed by November 10, 2001, a previously filed Appeal Brief having resulted in the Examiner's withdrawal of a prior final Office Action rejecting all claims) and in order to enable Applicants to take appropriate further action, expedited action on this Petition is respectfully requested.

Pursuant to the provisions of 37 C.F.R. 1.181(a)(3), and further to the Advisory Action dated August 14, 2001, and the Interview with the Examiner and Supervisory Examiner on October 16, 2001, granted pursuant to discussions with the Group Director and Supervisory Examiner initiated by Applicants' representative on August 28, 2001, Applicants petition the Commissioner to invoke his supervisory authority and to direct the Examiner to withdraw the finality of the Official Action of May 9, 2001.

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STATEMENT OF THE FACTS

In a non-final Action (Paper No. 20) of November 21, 2000, in response to an Appeal Brief filed August 29, 2000, a prior final Official Action rejecting all claims was withdrawn and all claims were again rejected as obvious under 35 USC § 103(a). Claims 1-6, 19-24, 27-29, 35, 37-38, 40-42, 44, 46 and 50 over Chang et al. (U.S. Patent No. 5,884,288) in view of Sharpe et al. (U.S. Patent No. 5,222,018). Claims 7, 25-26, 36 and 47 over the base combination in further view of Pintsov et al. (U.S. Patent No. 5,612,889). Claims 11, 30 and 48 over the base combination in further view of Mersky et al. (U.S. Patent No. 6,119,106). Claims 13-14 and 39 over the base combination in further view of Anderson et al. (U.S. Patent No. 6,021,202). Claims 15 and 49 over the base combination in further view of Anderson et al. (U.S. Patent No. 6,021,202) and Hilt et al. (U.S. Patent No. 5,465,206).

Applicants' representative responded, in a paper filed on February 8, 2001, with traversal arguments detailing why the Examiner's asserted interpretation of the applied art is inconsistent with the explicit teachings of the applied art itself. Additionally, claims 22-24 and 45-46 were cancelled without prejudice or disclaimer, and new claims 51-55 were added.

The Examiner replied in a Final Official Action (Paper No. 22) dated May 9, 2001, again rejecting all previously pending claims on the same grounds asserted in the November 21, 2000 Office Action and, as understood, rejecting new claims 51-54 under 35 USC § 103(a) as obvious over Chang et al. in view of Sharpe et al. and an Official Notice.

Applicants' representative responded, in a paper filed on July 9, 2001, with a request for reconsideration including traversal arguments again detailing why the Examiner's asserted interpretation of the applied art is inconsistent with the explicit teachings of the art itself. Additionally, the traversal arguments detailed why the Official Notice used in rejecting claims 51-54 is

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deficient and a request was made that the Examiner cite and apply prior art supporting the Official Notice if the rejection was to be maintained. It was also noted that no rationale was provided for the rejection of claim 55.

The Examiner replied in an Advisory Action (Paper No. 24) dated August 14, 2001, by stating "Receiving a set of payment requests for different payees from a "single payor" is not recited in the independent claims. The Examiner also notes that "claim 55 was inadvertently left out in the prior Office action. (See Other below)". In "Other" the Examiner states that "Claim 55 was rejected under the same rationale of claims 51, 52, 53 and 54."

Since, (i) none of the prior traversal arguments had asserted that the claims required a "single payor", but in fact had argued that the applied art did not make obvious the present independent claims because, *inter alia*, the primary Chang reference teaches that a single payor make requests for payment of only his/her own bills, (ii) no clarification was provided regarding the previously detailed inconsistencies between the Examiner's assertions of what is disclosed in the applied art and the express teachings within the art itself, and (iii) the Examiner's failure to provide any support for the Official Notice, Applicants' representative initiated communications with the Examiner's Supervisor and the Group Director beginning on August 28, 2001. At the Group Director's suggestion, an interview was arranged. Although Applicants' representative had requested that an interview be scheduled for September 2001, the Supervisory Examiner offered October 16, 2001 as the earliest date for an interview.

Accordingly, an interview took place on October 16, 2001. In attendance were the Examiner, Supervisory Examiner, Applicants' local attorney and the Patent Coordinator from the Ohio Office of the Assignee of all rights in the subject invention. As reflected in both the Examiner's Interview Summary and the Statement of Substance of Interview, the Supervisory Examiner refused to discuss

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other than claim 1 during the interview. The Supervisory Examiner attempted to justify his refusal on the basis that no agenda had been provided. However, no agenda, written or otherwise, had been requested. Not only was this disappointing to Applicants' local representative and the Assignee's (i.e. the customer's) representative who had flown in from Ohio to attend the Interview, but this also resulted in Applicants' representatives being unable to obtain any clarification regarding (i) the Advisory Action, since none of the prior traversal arguments had asserted that independent claims 19, 35, 41, or 50, or dependent claims 2-7, 11, 13-15, 20-21, 25-31, 36-40, 42-44, 47-49 or 51-55 require a "single payor", (ii) the previously detailed inconsistencies between the Examiner's position in rejecting independent claims 19, 35, 41, and 50, and dependent claims 2-3, 7, 11, 13-15, 21, 25-31, 36-40, 42-43, and 47-49 and what is disclosed in the applied art itself, and (iii) the Official Notice asserted in rejecting dependent claims 51-55.

Furthermore, as noted in the Statement of Substance of Interview, the Supervisory Examiner stated that Chang, the primary reference applied in rejecting the claims, is construed such that all of the requests from payors 202 are from a single source and therefor form a set of requests from a set of payors for payments to a plurality of payees. However, when the Supervisory Examiner was confronted with the fact that claim 1 expressly requires receiving respective sets of payment requests from a plurality of independent sources, and that even if his reading of Chang were correct, the applied art would still necessarily lack the required plurality of independent sources of claim 1, the Supervisory Examiner was unable to provide any further clarification of how, in view of these facts, the applied art could make obvious the invention recited in claim 1.

The prosecution history of the present application is summarized as follows:

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September 9, 1999 - Rejection of all claims under 35 U.S.C. 103(a) as obvious over Kight et. al. (U.S. Patent No. 5,383,113) in view of Pintsov et. al. (U.S. Patent No. 5,612,889).

November 18, 1999 - Amendment and traversal of rejections, noting inconsistencies between the Examiner's position regarding what is disclosed in the Pintsov reference and the express teachings within Pintsov itself.

February 29, 2000 - Final rejection of all claims under 35 U.S.C. 103(a) as obvious over Kight et. al. (U.S. Patent No. 5,383,113) in view of Pintsov et. al. (U.S. Patent No. 5,612,889).

April 25, 2000 - Request for Reconsideration traversing rejections, again noting inconsistencies between the Examiner's position regarding what is disclosed in the Pintsov reference and the express teachings within Pintsov itself.

May 12, 2000 - Advisory Action issued maintaining final rejection of all claims.

May 30, 2000 - Interview in which the Examiner and Primary Examiner agree claims distinguish over applied art if clarified by adding term "consolidated" to independent claims, and to enter amended claims if filed in Amendment After Final.

May 30, 2000 - Amendment After Final filed amending independent claims in accordance with agreement reached during interview.

June 14, 2000 - Entry of after final Amendment denied.

June 29, 2000 - Notice of Appeal filed.

August 29, 2000 - Appeal Brief filed arguing, *inter alia*, inconsistencies between the Examiner's position regarding what is disclosed in the Pintsov reference and the express teachings within Pintsov itself.

November 21, 2000 - Office Action issued withdrawing Final Official Action dated February 29, 2000 based on the Appeal Brief, and again rejecting all claims. Claim 49 is rejected under 35 USC § 112, second paragraph, as indefinite. Claims 1-6, 19-24, 27-29,

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35, 37-38, 40-42, 44, 46 and 50 are rejected under 35 USC § 103(a) as obvious over Chang et al. (U.S. Patent No. 5,884,288) in view of Sharpe et al. (U.S. Patent No. 5,222,018). Claims 7, 25-26, 36 and 47 are rejected under 35 USC § 103(a) as obvious over the base combination in further view of Pintsov et al. (U.S. Patent No. 5,612,889). Claims 11, 30 and 48 are rejected under 35 USC § 103(a) as obvious over the base combination in further view of Mersky et al. (U.S. Patent No. 6,119,106). Claims 13-14 and 39 are rejected under 35 USC § 103(a) as obvious over the base combination in further view of Anderson et al. (U.S. Patent No. 6,021,202). Claims 15 and 49 are rejected under 35 USC § 103(a) as obvious over the base combination in further view of Anderson et al. (U.S. Patent No. 6,021,202) and Hilt et al. (U.S. Patent No. 5,465,206).

February 8, 2001 - Amendment of dependent claim 49 to overcome indefiniteness rejection, cancellation of dependent claims 22-24 and 45-46 without prejudice or disclaimer, addition of new claims 51-55, and traversal prior art rejections, arguing inconsistencies between the Examiner's position regarding what is disclosed in the Chang, Pintsov, Mersky and Anderson references and the express teachings of these references themselves.

May 9, 2001 - Final Office Action issued again rejecting all previously pending claims on the same prior art grounds as asserted in Official Action of November 21, 2000, and (as understood) rejecting new claims 51-54 under 35 USC § 103(a) as obvious over Chang et al. in view of Sharpe et al. and an Official Notice.

July 9, 2001 - Request for Reconsideration again detailing why the Examiner's asserted interpretation of the Chang, Pintsov, Mersky and Anderson references is inconsistent with the explicit teachings of these references themselves. Additionally, the traversal arguments detail why the Official Notice applied in rejecting claims 51-54 is deficient and request that the Examiner cite and apply prior art supporting the Official Notice if the rejection is to be maintained. It was also noted that no rational

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had been provided for the rejection of dependent claim 55.

August 14, 2001 - Advisory Action stating "Receiving a set of payment requests for different payees from a "single payor" is not recited in the independent claims. The Examiner notes that claim 55 was inadvertently left out in the prior Office action. (See Other below)." In "Other" the Examiner states that "Claim 55 was rejected under the same rational of claims 51, 52, 53 and 54."

August 28, 2001 - Begin discussions with Supervisor seeking clarification of Examiner's position because (i) contrary to Advisory Action, prior traversal arguments did not assert that the claims required a "single payor", (ii) no clarification had been provided regarding the previously detailed inconsistencies between the Examiner's reading of the applied prior art and the express teachings within the applied prior art itself, and (iii) the Examiner's failure to provide any support for the Official Notice.

October 16, 2001 - Interview with Examiner, Supervisory Examiner, Applicants' attorney and the Assignee's Patent Coordinator from Ohio. During the interview, the Supervisory Examiner refused to discuss any claims other than claim 1. Accordingly, no clarification was provided regarding the Advisory Action, inconsistencies between the Examiner's reading of the prior art and the express teachings within the art itself, and the Examiner's failure to provide any support for the Official Notice, with respect to independent claims 19, 35, 41, or 50, or dependent claims 2-7, 11, 13-15, 20-21, 25-31, 36-40, 42-44, 47-49 or 51-55. Furthermore, the Supervisory Examiner was unable to clarify the basis for the final rejection when confronted with the fact that under his asserted reading of Chang, the applied art would necessarily lack an express limitation within claim 1.

POINTS TO BE REVIEWED

Whether the Examiner's and the Supervisory Examiner's failure
1) to provide clarification regarding (i) the relevance of the

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assertion made in the Advisory Action, (ii) the rationale for the final rejection of all claims in view of the noted inconsistencies between the Examiner's reading of the prior art and the express teachings within the art itself, and (iii) the Official Notice, and 2) to provide clarification as to the basis for the final rejection of claim 1 when, even if the Supervisory Examiner's stated reading of Chang was correct, the applied art would logically lack an express limitation within claim 1, evidences a failure to comply with the mandates of MPEP §706.07, thereby making the final rejection premature.

ARGUMENT

MPEP §706.07 clearly requires that "before final rejection is in order a clear issue should be developed between the Examiner and applicant." Indeed, the Manual states that "the references should be fully applied" (emphasis added), so as to deal justly with the applicant as well as the public. The Manual goes on to state that "present practice does not sanction hasty and ill-considered final rejections". "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end." "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." (emphasis added).

In the present instance, claims presented and pending in the application were rejected over prior art based on a construction of the applied art inconsistent with its own teachings, without considering recited claim limitations, and without providing an understandable rationale for the rejection, notwithstanding the repeated efforts by Applicants' representative to highlight the inconsistency between the Examiner's position and the express

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teachings in the applied prior art, and repeated requests for clarification so that Applicants could form a reasonable understanding of the basis for the rejection. Instead, the rejection of the claims over the prior art has been maintained, as indicated in the Advisory Action and the Interview Summary Record, without even the Examiner's Supervisor being able to provide a reasonable explanation of the basis for the rejection of claim 1. Worse yet, when ask to explain the rejection of claims other than claim 1, the Supervisor refused to even discuss the other claims, and attempted to justify this refusal on the basis that no agenda for the interview had been provided.

Because of the failure to explain the relevance of the assertion made in the Advisory Action, the rationale for the final rejection of all claims in view of noted inconsistencies between the Examiner's reading of the prior art and the express teachings within the art itself, the basis for the Official Notice taken, and the basis for the final rejection of claim 1 when under the Supervisory Examiner's own reading of Chang the applied art necessarily lacks an express limitation within claim 1, a clear issue was never reached with respect to the final rejection of the claims. The attempts which the Applicants' representative has made to obtain the clarification necessary to forming a reasonable understanding of the basis for the rejection of the claims during the prosecution and develop a clear issue in this case have been completely frustrated by the Examiner's and the Supervisory Examiner's apparent refusal to even consider the inconsistencies between the asserted interpretation of the applied prior art and its own teachings, notwithstanding repeated requests to do so. It is perhaps worthwhile to again emphasize that these requests for clarification have been made by explicitly pointing out the inconsistencies between the Examiner's position and the applied art disclosures in responses to the Official Action of November 21, 2000 and the final Official Action of May 9, 2001, as well as in

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the earlier filed Appeal Brief and responses filed prior thereto.

Furthermore, the Examiner's assertion in the Advisory Action of August 14, 2001 indicates that, more than 3.5 years into prosecution, the Examiner appears to lack an understanding of the express claim limitations, or the ability to provide any reasonably understandable rationale for the rejection of the claims.

Further still, and perhaps most telling of all, even the Supervisory Examiner has been unable to interpret the applied prior art to meet all the express limitations of independent claim 1, and has refused to even attempt to clarify the basis for the rejection of the other claims. Hence, the Applicants are left with no clear understanding of the rationale for the rejections.

Thus, it is apparent that the Examiner has refused to properly construe the applied prior art, to provide a reasonable rationale for rejection of the claims based on that which the prior art discloses, and has thus defeated the stated goal of reaching a clearly defined issue.

Although the extended prosecution history clearly shows that a final Action at this time would not be "hasty" from a chronological point of view, such a final Action is clearly "ill-considered" from a procedural perspective since neither the Examiner nor the Supervisory Examiner has been able to provide a reasonable rationale which supports the rejection. In fact, the Supervisor's refusal to even attempt to discuss the basis for the rejection of the independent claims other than claim 1, can only be viewed as evidence of the unfair treatment which Applicants have received during the course of prosecution of this application.

Indeed, by issuing and maintaining the final rejection in the Advisory Action, and after a subsequent Interview in which even the Supervisor was unable to reconcile the lack of correspondence between the prior art teachings according to his own interpretation and the express claim requirements, it is clear that there is no reasonable rationale for the final rejection of the claims.

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Further, it can only be concluded that the rejection has been made without reasonable consideration of the arguments offered in traversal of the finality of the rejection or the inconsistencies between the Examiner's asserted interpretation of the prior art and its express teachings. Applicants have clearly not been provided with the "cooperation of the Examiner" required under MPEP § 706.07 in defining the invention by claims that will give Applicants the patent protection to which they are "justly entitled".

It should be noted that prosecution of the application has not been extended by any "dallying" on the part of Applicants. Rather, the refusal of the Examiner and Examiner's Supervisor to properly construe the prior art, to provide a reasonable explanation of the basis for the rejection, or to even discuss the rejection of other than claim 1 has placed Applicants in a position of having to establish patentability without having any way of knowing why patentability is in issue. Since, in view of the above, the Examiner has clearly failed to establish a prima facie case of obviousness, there can be no clear issue. In fact, the Examiner's tactics appear to be an attempt to place the onus on the Applicants to establish a prima facie case of patentability contrary to the law and the rules of practice.

There are no technical or other "subterfuges" to which Applicants resort. Rather, Applicants simply wish to see a proper application of the art of record to the claims. Only then will a clear issue be developed to which Applicants can be reasonably expected to respond and/or from which they can properly appeal to the Board.

In relevant part, MPEP § 707.07(g) instructs an Examiner that "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression". In the present instance, based on identified differences between Chang, as interpreted by the Supervisory Examiner, and the claim 1 recitals, as well as the

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Supervisory Examiner's inability to provide any reasonable rationale for the rejection of claim 1 in view of these differences, it can only be concluded that the rejection also fails to even consider limitations of the invention, as recited in the claim 1. This further evidences that there has been no "full development of reasons" during the prosecution of this case.

To permit the Examiner and Examiner's Supervisor to end prosecution after instituting improper grounds for rejection of claims which have not considered recited features of the claims or a proper interpretation of the applied prior art, would permit disposal of complex cases by hastily rejecting claims without complete consideration and without full development of the reasons for the rejection, and then to foreclose applicants from an opportunity to focus the issues by maintaining the ill-conceived rejection in total disregard of the rebuttal arguments and the Commissioner's mandates. Such action should be discouraged since it is not only inconsistent with the Rules of Practice but violates Applicant's due process rights.

Had the Examiner responded to the rebuttal arguments submitted by Applicant's representative by repeating the rejection after reasonably addressing the submitted traversal arguments (including the inconsistencies between the Examiner's position and the express teaching within the applied prior art, and each of the claim limitations), an issue would have been reached and Applicants would have been in a position to appeal. However, the Examiner and Supervisory Examiner have instead chosen to ignore the rebuttal and MPEP mandates, and simply stand firm on an incomplete rejection.

In all fairness, the provisions of MPEP § 706.07(a) require that Applicants be given a full opportunity to receive a reply from the Examiner which reflects a proper construction of the applied prior art, applies the properly construed prior art in view of all the claim limitations, and presents a reasonably understandable basis for the rejection addressing all the limitations of the

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claims in order to develop a clear issue between Applicant and the Examiner before appeal.

CONCLUSION

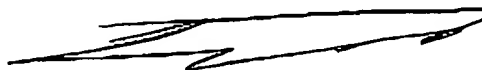
Applicant is not requesting extended prosecution. Applicant is simply requesting fairness and cooperation, compliance with the provisions of the MPEP, and constitutionally mandated due process. The Commissioner is thus requested to exercise his supervisory authority and direct the Examiner and Examiner's Supervisor to withdraw the premature finality of the Action of May 9, 2001, and to cooperate with Applicant's representative either in defining the invention in the claims to which they are justly entitled or in developing a clear issue for appeal.

It is respectfully requested that the undersigned be contacted by telephone at the below listed local telephone number, in order to expedite resolution of any issues, if any further comments, questions or suggestions arise in connection with the filing.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time and petition fees, to Deposit Account 12-0429 and please credit any excess fees to such deposit account.

Respectfully submitted,

Lalos & Keegan



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